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EXAMINER

DINH, TAN X

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2627

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,954

Applicant(s)

HWANG ET AL.

Examiner

TAN X. DINH

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1) The amendment/Certified Translation of priority Documents filed on 11/20/2007 is acknowledged. Claims 2,3,6-21 and 25-42 are have been canceled.

2) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ 2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ 2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3) Claims 1,4,5 and 22-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-21 of copending Application No. 10/831,372.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim(s) 15-21 of copending Application No. 10/831,372 recite all the subject matter as claimed in claim(s) 1,4,5 and 22-24 of this instant application, such as, a write once optical disc with at least one record layer comprises at least one temporary defective management area in which temporary defect information and temporary defect management information comprising a pointer indicating an area in which the temporary defect information is recorded, are recorded, an access information area in which location information regarding an area in which the updated predetermined information is recorded, is recorded, except to specifically show that the location information comprises a physical or logical address of the area in which the temporary defect information is recorded. However, in the optical recording art, the location information always indicates physical address or logical address of data during recording or reproducing processes, this different is not a patentable weight since the body of these claims recite the same structures and/or functions with each other and this would not make them a patentable distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6) Claims 1,4,5,22,23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over GOTOH et al (6,581,167).

GOTOH et al discloses an optical disc with at least one record layer as claimed in claim 1, comprises at least one temporary

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defective management area in which temporary defect information and temporary defect management information comprising a pointer indicating an area in which the temporary defect information is recorded, are recorded (figure 1, defective management area 101, area 133 indicates location information defective sector 136), an access information area in which location information regarding an area in which the updated predetermined information is recorded, is recorded (Fig.1, update areas 116, 137), wherein the location information comprises a physical or logical address of the area in which the temporary defect information is recorded (abstract), *except to specifically show that the optical disc is write-once optical disc.* Examiner take Official Notice the fact that write-once optical disc (CD-WO) is known in the recording art to be equivalent to any types of optical disc (CD-RW or DVD-RAM, DVD-RW, etc.,) for storing information data. Therefore, to substitute write-once optical disc in GOTOH et al's optical disc recording system as claimed is deem obvious to someone within the level of skill in the optical recording art.

Apparatus claim 22 drawn to the apparatus of using the corresponding recording medium claimed in claim 1. Therefore, apparatus claim are rejected for the same reasons of anticipation (obviousness) as used above.

As to claims 4 and 5, GOTOH et al shows the location information is recorded in access area several times and when the updated information reaches a predetermined number (Fig.1, 110-116 and 120-122).

As to claim 23, GOTOH et al shows controls the recording/reading unit to record the location information in the access information area several times (Fig.1, the location information 136, 137 can be recorded on access information area as many times).

As to claim 24, GOTOH et al shows to record the location information in the access information area whenever a predetermined number of blocks of the area are filled with information (Fig.1, the location information 136, 137 can be recorded at any times during recording process).

7) Claims 1,4,5,22,23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over SHIN (6,529,458).

SHIN discloses an optical disc with at least one record layer as claimed in claim 1, comprises at least one temporary defective management area in which temporary defect information and temporary defect management information comprising a pointer indicating an area in which the temporary defect information is recorded, are recorded (Fig.5, defective management area, DMA1, DMA2, DMA3, DMA4. Figure 6, step 607 write data on defective area at position the write command

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designated), an access information area in which location information regarding an area in which the updated predetermined information is recorded, is recorded (Fig.5 LIA, data area and LOA are all access information areas), wherein the location information comprises a physical or logical address of the area in which the temporary defect information is recorded (Fig.6, step 608 for storing position information of defective area, position information always contains either physical or logical address of the area in which the temporary defect information is recorded. See also figure 9, steps 906, 907, 908 and 909), *except to specifically show that the optical disc is write-once optical disc. Examiner take Official Notice the fact that write-once optical disc (CD-WO) is known in the recording art to be equivalent to any types of optical disc (CD-RW or DVD-RAM, DVD-RW, etc.,) for storing information data.* Therefore, to substitute write-once optical disc in GOTOH et al's optical disc recording system as claimed is deem obvious to someone within the level of skill in the optical recording art.

Apparatus claim 22 drawn to the apparatus of using the corresponding recording medium claimed in claim 1. Therefore, apparatus claim are rejected for the same reasons of anticipation (obviousness) as used above.

As to claims 4 and 5, SHIN shows the location information is recorded in access area several times and when the updated information reaches a predetermined number (Fig.5, DMA1, DMA2, DMA3, DMA4 and figure 9, steps 906-909, the location information can be recorded at any number of times).

As to claim 23, SHIN shows controls the recording/reading unit to record the location information in the access information area several times (Fig.5, DMA1, DMA2, DMA3, DMA4 and figure 9, steps 906-909, the location information can be recorded at any number of times).

As to claim 24, SHIN shows to record the location information in the access information area whenever a predetermined number of blocks of the area are filled with information (Fig.5, DMA1, DMA2, DMA3, DMA4 and figure 9, steps 906-909, the location information can be recorded at any times during recording process).

8) Applicant's arguments filed 11/20/2007 have been fully considered but they are not persuasive.

The new features are found in GOTOH et al (see Abstract). It is clearly to someone in the recording art that the location information must contains either physical or logical address where temporary defect information is recorded. Further, the location information also found in SHIN (Fig.9, steps 906-909).

For that reasons, the claims are still found rejectable as shown above.

9) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the

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state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner TAN Xuan DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY to FRIDAY from 8:30AM to 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

February 4, 2008